

## REMARKS

In response to the Final Rejection in the Office Action mailed November 4, 2003, applicants submit the following remarks that are directed to only placing the pending claims in order for allowance. No new issues are raised by way of this response.

In paragraphs 1 - 4 of the Office Action, the Office Action has rejected claims 10-17 and 20-21 as being anticipated under 35 U.S.C. §102(e) by U.S. Pat. No. 6,327,578 to Linehan (“Linehan”).

In contrast to Linehan, for which preauthorization is important (see column 5, lines 50-54), the claimed invention does not require preauthorization. According to Linehan, an issuing bank’s certificate identifies and authenticates the issuing bank to a merchant, which, in turn, provides a basis for the merchant to trust the authorization token provided by the issuing bank. However, as clearly pointed out in the present application, no such authentication of the issuing bank (the financial institution of the buyer) to the merchant directly is required. Instead, the merchant’s bank authenticates the buyer’s bank if and when required. The merchant is authenticated by the merchant’s bank as well. Therefore, neither the spirit nor the actual disclosure of Linehan anticipates or even suggests the claimed invention. This is explained further in the context of the pending claims.

Turning to the specific rejections, either the rejection of claims 10 and 20 is based on a mistaken reading of Linehan, or if the Office Action’s interpretation of Linehan is followed to its logical conclusion, then rather than anticipating claims 10 and 20, Linehan teaches away from the claimed invention by way of teaching a security breach that is not present in the claimed invention. The Office Action identifies the elements of each of independent claims 10 and 20 in an inconsistent manner in the disclosure of Linehan. For instance, the Office Action identifies, in paragraph 2, a buyer as consumer 102 or 202 in Fig. 1 of Linehan. But, then it goes on to identify the first customer as the issuing bank 212. Furthermore, the Office Action alleges that in accordance with Linehan’s disclosure the issuing bank goes on to sign the alleged payment instruction with a private key “corresponding to a digital certificate of the buyer.” See paragraph 2 of the Office Action.

This security breach is not present in the claimed invention since the unambiguous language of either of the rejected claims 10 and 20 specifically recites “the *buyer* signing the payment instruction message with a private key corresponding to a digital

certificate of the *buyer*” (emphasis added). In the context of Linehan, the cited text actually identifies the issuing bank as signing the alleged payment instrument with its own private key, which is not even alleged to anticipate the rejected claims.

Indeed, the interpretation adopted by the Office Action is also at variance with the explanation of private/public key pairs provided by Linehan itself, which notes, see column 2, lines 36-43, that “when used for signing, the signer uses the private key half to sign a message and the recipient uses the public key half to verify the signature.” In other words, the private key is private to the signer rather than being provided to a bank and the like. Thus, the Office Action’s attempt to use the disclosure of Linehan to support an argument for anticipation of the claimed invention is likely based on a mistaken reading of Linehan. Therefore, applicants respectfully request withdrawal of the rejection of independent claims 10 and 20 since Linehan does not disclose an entity corresponding to a buyer for signing a payment instrument with the buyer’s private key.

The shortcoming of Linehan in disclosing a buyer signing using the buyer’s private key is also conceded elsewhere by the Office Action, in paragraph 7, while discussing the rejection of claims 1, 18 and 19. Thus the rejection of independent claims 10 and 20 is also inconsistent with the later admission by the Office Action that Linehan fails to teach “an inventive concept” in which the first customer signs the payment instruction with its private key and the second customer signs the payment instruction with its private key.”

In paragraph 5-10, the Office Action has rejected claims 1-9, 18 and 19 under 35 U.S.C. §103(a) as being unpatentable over Linehan in view of U.S. Pat. No. 6,039,248 to Park et al. (“Park”). Specifically, the Office Action alleges that the four party protocol of Park corresponds to the four-corner model disclosed in the present application. The Office Action then concedes, in paragraph 7, that Linehan does not teach the inventive concept of the first customer, for instance, the buyer, signing the payment instruction with its private key and the second customer signing the payment instruction with its private key.

However, the Office Action alleges that Park does teach this inventive concept (that is otherwise missing in Linehan). Applicants respectfully disagree. Applicants are assuming, in the absence of any clarifications to the contrary, that the Office Action is treating the certificate sent by the notarizing organization (in the description of Park) as corresponding to the payment instruction of the claimed invention. It is then clear from the cited portion of Park that the customer and the merchant sign different documents,

which are expressly illustrated in Figures 5 and 6 respectively. The cited portion of Park discloses that customer signs an electronic notarization document and sends it to the notarizing organization and meanwhile the merchant also receives a like document from the notarizing organization, which it signs and sends back to the notarizing organization. In contrast, claim 1 recites “the first customer transmitting the payment instruction to the second customer.” Therefore, not only are the signed documents different, this difference is supported by a comparison of the flow of documents disclosed by Park with that in the claimed invention. Therefore, the inventive concept of the first customer signing the payment instruction with its private key and the second customer signing the payment instruction with its private key missing from Linehan is also not taught by Park.

The Office Action alleges that the authorization token of Linehan is a payment instruction that is completed by the buyer. Assuming this correspondence to be correct, this is another example of a difference between the claimed invention and the disclosure of Linehan that is not cured by Park. Specifically, Linehan does not disclose the step, in claim 1, of the “first customer completing a buyer’s portion of a payment instruction.” In Linehan there is no teaching, disclosure or suggestion of the first customer adding anything to the authorization token (which is alleged by the Office Action to correspond to the payment instruction) in the cited portion of Linehan. Thus, contrary to the allegation of the Office Action, there is no disclosure in Linehan of the buyer completing the ‘authorization token.’ Instead, the issuer gateway is disclosed to send the authorization token, see col. 6, lines 15-21 of Linehan. Therefore, the alleged payment instruction of Linehan is not the same as that in the claimed invention.

Since, Park does not teach, disclose or suggest a customer completing the certificate (the alleged payment instruction of the claimed invention), a step distinct from signing the certificate, it too cannot cure the acknowledged deficiency of Linehan. Therefore, the combination of Linehan with Park also does not teach, disclose, or suggest all of the limitations of any of the claims 1, 18 and 19.

Accordingly, applicants respectfully request that the rejection of claim 1 be withdrawn in light of the preceding discussion. Since, claims 18 and 19, rejected on grounds similar to claim 1, also recite this limitation (a buyer completing a buyer’s portion of a payment instruction) that is not taught, disclosed or suggested by Linehan and Park, considered separately or in combination, applicants respectfully request that their rejections under 35 U.S.C. §103(a) also be withdrawn.

Further, patentability of claim 1 axiomatically makes claims 2-8 dependent upon it also patentable. Therefore, applicants respectfully request that the rejection of claims 1-9, 18 and 19 be withdrawn.

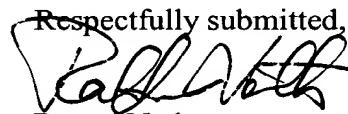
Should the Office Action disagree and elect to maintain its rejection of claim 1, applicants respectfully request that a specific citation to the relevant portions of Linehan or Park be provided or other clarifications to specifically identify the payment instruction and the various parties identified in the claimed invention be provided to assist the applicants in formulating an appropriate response. The efficiencies realized by the particular functions carried out by the various parties in accordance with the claimed invention resulting in more secure and speedy transactions are due, in part, to the interactions between the various parties. Thus, a specific correspondence is required to adequately support an allegation of anticipation of the claimed invention by Linehan.

Applicants respectfully request entry of this detailed response since it is directed to only placing the application in order for allowance. No new matter is introduced by way of this response.

The original due date for this Response was February 4, 2004. Accordingly, a Petition for Extension of Time (for three month) is filed herewith which renders this Response timely. Please charge any required fees in connection with this Petition, as well as any other necessary fees due in connection with this Response, to JONES DAY Deposit Account 503013.

In light of the above, it is respectfully submitted that the present application is in condition for allowance. Favorable disposition is respectfully requested.

Date      May 4, 2004

Respectfully submitted,  


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